

REMARKS

Claims 1 to 22 were pending in the application at the time of the advisory action. Claims 1 to 4, 7 to 11, 14 to 18, 21 and 22 stand rejected as anticipated. Claims 5, 6, 12, 13, 19, and 20 stand rejected as obvious.

Claims 1, 8, 15, and 22 are amended to include features inherent in the original claim. Specifically, index page types in the list of index page types are included as defined in the specification. Accordingly, these amendments only clarify the invention and in particular the definition of index page types.

Claims 1 to 4, 7 to 11, 14 to 18, 21 and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,937,163, hereinafter Lee.

Applicant respectfully continues to traverse the anticipation rejection of Claim 1. Applicant respectfully notes that despite quoting the requirements from the MPEP for an anticipation rejection, the Examiner apparently continues to redefine elements and the position in the elements disclosed in Lee as evidenced in the advisory action.

Specifically, the Examiner cited element 120' in Fig. 10 of Lee as teaching exactly

displaying a window including a list of index line types for one index page type upon selection of said one index page type in said list of index page types.

However, Lee stated "Note also the change in the iconic image of the Library icon 121' in the book shelf 120'. (Lee, Col. 14, lines 43-45.) Thus, Element 120' is described by Lee as "a book shelf." Earlier Lee stated "a row of icons 120 referred to as a book shelf. . . . The bookshelf 120 includes a number of smaller book icons 121-125, labeled library 121 . . ." Lee, Col. 11, lines 57-58.

The Examiner has cited no teaching that this row of icon is displayed "upon selection of one index page type." Moreover, a row of icons is not a list of index line types when a list of index line types is interpreted as required by the MPEP.

The Examiner is required to show how the reference teaches exactly what is claimed, as noted in the response to the final office action. Applicants have requested an examiner interview to better understand the Examiner's basis for this position, which appears to be in direct contradiction to the express teachings of the reference and the requirements of the MPEP, as previously quoted and incorporated herein by reference.

This is further confused because the Examiner also cited the bookshelf of Lee as teaching exactly:

displaying a token string including a plurality of tokens, upon selection of one index line type in the list of index line types, wherein the plurality of tokens includes only tokens appropriate for the one index line type

In particular against this element the Examiner cited Col. 11 lines 53 to 67 of Lee. However, these lines describe the bookshelf as quoted above.

The Examiner has used the bookshelf icons as teaching exactly both a token string and as a list of index line types as quoted above. However, as recited in the claims, the token string is for a particular index line type. The bookshelf and the icons in the bookshelf cannot teach both claim elements and the Examiner has cited no teaching that the bookshelf or the icons are displayed in response to any selections.

The MPEP requires that express limitations be considered and that the claims are not interpreted in a vacuum. Again, Applicant has requested an interview to understand the basis for the redefinitions and rearrangement of the hierarchical order of Lee that has been relied upon by the Examiner.

Claim 1 defines a relationship between the index page type and the index line type, and between the index line type and the token string. Book icons are at the top of Lee's hierarchy and to suggest that such top hierarchy icons teach limitations at a lower level hierarchy in Applicant's Claim 1 requires a modification of Lee.

Finally, the Examiner has cited no teaching of index page types and elements for those index page types as recited in Claim 1. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 1.

Claims 2 to 4, and 7 depend from Claim 1 and so distinguish over the cited reference for at least the same reasons as Claim 1, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 2 to 4, and 7.

With respect to the anticipation rejection of Claim 8, Claim 8 recites "an insert index page dialogue window." As quoted above, Fig 10 of Lee is a book image displayed when a book icon is selected. The book image is a display of "the URLs and HTMLS recorded for the topic." This has nothing to do with a graphic user interface that includes "an insert index page dialogue window." In addition, the above comments concerning Claim 1 are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 8.

Claims 9 to 11, and 14 depend from Claim 8 and so distinguish over the cited reference for at least the same reasons as Claim 8, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 9 to 11 and 14.

With respect to Claim 15, the language discussed above with respect to Claim 1 is included in Claim 15. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 15.

Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 15.

Claims 16 to 18, and 21 depend from Claim 15 and so distinguish over the cited reference for at least the same reasons as Claim 15, which are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claims 16 to 18 and 21.

With respect to Claim 22, the language discussed above with respect to Claim 1 is included in Claim 22. Therefore, the comments with respect to Claim 1, which are incorporated herein by reference, are directly applicable to Claim 22. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 22.

Claims 5, 6, 12, 13, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,937,163 (Lee) in view of U.S. Patent No. 5,623,679, hereinafter Rivette.

Assuming that the combination of references is appropriate and the characterization of Rivette is correct, the information relied upon by the Examiner from the secondary reference fails to address the shortcomings of the primary reference and noted above for Claims 1, 8, and 15. Therefore, each of Claims 5, 6, 12, 13, 19 and 20 distinguishes over the combination of references. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 5, 6, 12, 13, 19, and 20.

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Appl. No. 09/728,56

Amdt. dated April 5, 2004

Reply to Advisory Action of February 10, 2004

Claims 1 to 22 remain in the application. Claims 1, 8, 15, and 22 have been amended. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 5, 2004.

Respectfully submitted,



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April 5, 2004  
Date of Signature